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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,672	10/19/2000	Gregory L. Slaughter	5181-72200	7201

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EXAMINER

PATEL, HARESH N

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,672

Applicant(s)

SLAUGHTER ET AL.

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 51-73, 100-117, 136 and 138 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-11, 57-60 and 106-109 is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-24, 51-56, 61-73, 100-105, 110-117, 136 and 138 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/14/2005 (2)</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24, 51-73, 100-117, 136 and 138 are subject to examination. Claims 25-50, 74-99, 118-135, 137 and 139 are cancelled.

Response to Arguments

2. Applicant's arguments filed 1-7, 12-24, 51-56, 61-73, 100-105, 110-117, 136 and 138 have been fully considered but they are not persuasive. Therefore, rejection of claims 1-7, 12-24, 51-56, 61-73, 100-105, 110-117, 136 and 138 is maintained.

Applicant argues (1), "The Examiner's reliance on Tuatini is misplaced as discussed as bridging and proxy service is not well-known in the art as asserted by the examiner. Therefore, the Examiner's double patenting rejection is not supported by the cited art".

The examiner respectfully disagrees to the applicant's argument. Tuatini discloses the well-known use of bridging and proxy service (e.g., col., 14, paragraph 122 – col., 15, paragraph 132). Further, Machin also discloses the well-known concept of bridging and proxy service (e.g., col., 12, paragraphs 136 – 138, abstract). Pitts, 6,505,241, also discloses these limitations, (e.g., col., 8, lines 4 – 27, col., 47, line 30 – col., 48, line 45). Mead et al., 6,601,728 also discloses these limitations, (e.g., col., 3, lines 1 – 29). Alexander Jr. et al., IBM, 5,946,311 also discloses these limitations (col., 7, line 53 – col., 8, line 6). Giese, Nortel Networks Limited, 6,621,895, also discloses these limitations (e.g., col., 18, lines 5 – 58). Cheng, 2001/0032273 also discloses these limitations (e.g., paragraph 57). Glide et al., F5 Networks Inc., 2001/0037387 also discloses these limitations (e.g., paragraph 90). Machin et al., 2002/0032806,

also discloses these limitations (e.g., paragraph 136). Szabo 2002/0138618 also discloses these limitations (e.g., paragraph 99). Therefore, the double patenting rejection is maintained.

Applicant argues (2), Tuatini do not disclose, teach, or suggest the applicant's claimed, sending a schema to the client application, sending a schema defining messages in a data representation language for accessing the directory service, a proxy service sending the XML DTD to a client component".

The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, "a schema to the client application, sending a schema defining messages in a data representation language for accessing the directory service, a proxy service sending the XML DTD to a client component", are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See *In re Wilder*, 166 USPQ 545, 548 (CCPA 1970). Considering the claimed limitations to which the applicant is concerned, it seems that applicant is implying that the cited references do not disclose "proxy client" / "accessing of a Jini Service proxy from clients", which the claims are not limited to. What is claimed is, "the proxy service, sending to the first entity a schema defining message, schema defining messages in a data representation language". Contrary to applicant's assertions, the cited reference, Tuatini discloses these limitations, the proxy service (e.g., col., 14, paragraph 122 – col., 15, paragraph 132), sending to the first entity a schema defining message (e.g., XML DTD available to others on the network and retrieving of the XML

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DTD from the shared location, paragraphs 122 – 130), schema defining messages in a data representation language (e.g., XML DTD available to others on the network and retrieving of the XML DTD from the shared location, paragraphs 122 – 130). The specification of this application, page 203, lines 14 – 19, clearly state, “Various modifications and changes may be made as would be obvious to a person skilled in the art having the benefit of this disclosure. It is intended that the invention embraces all such modifications and changes and, accordingly, the specifications, appendices and drawings are to be regarded in an illustrative rather than a restrictive sense”. Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant argues (3), “This rejection is improper because the Examiner has not shown that Tuatini qualifies as a prior art reference”, “Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional applications, it is unclear whether the material in Tuatini relied upon by the Examiner was actually present in Tuatini’s provisional applications”.

The examiner respectfully disagrees in response to applicant's arguments. The provisional applications, i.e., 60/173,666 and 60/173,712, available using IFW / EDAN, not only shows that the subject matter on which the is relied upon to reject the claims is present in the Tuatini’s provisional applications, but also shows at least one claim of the published utility application is supported in the provisional application, e.g., pages 4, 16, 78, 112, 236, 324 and 428 (Also see pages 305 – 323 for further clarification). Hence, Tuatini is qualified as a prior art reference. Therefore the rejection is maintained.

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Applicant states (4), “examiner to provide a legible copy of page 324 of the 60/173,712”. For clarification; both applications, 60/173,666 and 60/173,712, are available using IFW / EDAN. Examiner is not providing a copy of the page 324, which the applicant already has access to and the applicant already reviewed. Regarding to the contents of the flowchart (figure) of the page 324, applicant is requested to see the related pages of the applications that describe and are related to the flowchart (figure).

Applicant argues (5), “Mead teaches a system in which multiple proxy devices coordinate to communicate messages between local area networks via a wide area network using a transparent bridging system. Specifically, Mead teaches the use of a master proxy device that mediates and selects which of the proxy devices should handle which messages sent between a local area network and a wide area network”, “Mead’s proxy devices only route messages”, “only discloses a transparent bridging mechanism”, “Mead’s system are not aware of Mead’s proxy devices at all and do not view the proxy devices as some other entity in the computing environment”, hence, Mead cannot teach the relied upon limitations.

The examiner respectfully disagrees in response to applicant's arguments. The cited reference, i.e., Mead’s teachings and disclosure are not limited to the applicant assertions. Contrary to applicant’s assertions, Mead also discloses the well-known concept of using the proxy service that appears to the first entity as the second entity (e.g., col., 3, line 1 – col., 4, line 24). Attached is copy of computer dictionary that contain well-known definitions i.e., proxy, bridge, schema, etc. Also, the specification of this application, page 203, lines 14 – 19, clearly state, “Various modifications and changes may be made as would be obvious to a person skilled in the art having the benefit of this disclosure. It is intended that the invention embraces all such

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modifications and changes and, accordingly, the specifications, appendices and drawings are to be regarded in an illustrative rather than a restrictive sense". Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant argues (6), "cited references, i.e., Tuatini, AAPA (applicant's admitted prior art) do not contain a suggestion, or motivation to modify or to combine with each other. The examiner respectfully disagrees in response to applicant's arguments. In response to the references containing a suggestion, or motivation to modify or to combine with each other, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Tuatini discloses a method for bridging a first computing environment based upon a message passing model to a second computing environment (e.g., heterogeneous distributed environment, figure 1, col., 14, paragraph 122 – col., 15, paragraph 140). AAPA discloses the well-known concept of using Jini environment (e.g., Jini environment, pages 2-6 of the specification). The Jini environment would provide access to the Jini services. The Jini services would provide information to the client over the network. The client would utilize the provided information. Therefore, the rejection is maintained.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24, 51-73, 100-117, 136 and 138 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,868,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent teaches the limitations as disclosed such that the interpretation of a first entity accessing a second entity through messages in a data representation language is equivalent to a first client sending a first message to a first service and the first service generating a set of results in response to the first message, wherein the set of results are expressed in a data representation language and using a space, advertisement, XML, and URI. The limitations of dependent claims 2-24, 52-73, 101-117, are similar to claims 2-45 of the Patent No. 6,868,447. The claimed subject matter of the Patent No. 6,868,447 does not mention about bridging, usage of proxy service and client method gate. However, the concept of bridging, usage of proxy service and client method gate is well known in the art, for example, Tuatini discloses the well-known use of bridging and proxy service (e.g., col., 14, paragraph 122 – col., 15, paragraph 132). Machin discloses the well-known concept of using client method gate

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(e.g., usage of client proxy component, col., 12, paragraphs 136 – 138). The bridging and proxy service would help two entities from different computing environment to communicate with each other. The client gate would enhance communication support at the client entity.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 138 is rejected under 35 U.S.C. 102(e) as being anticipated by Tuatini, as per office action dated 7/11/2005.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 19-21, 23, 24, 51-55, 68-70, 72, 73, 100-103, 113, 114, 116 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuatini in view of Mead et. al. 6,061,728 (Hereafter Mead), as per office action dated 7/11/2005.

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7. Claims 136 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuatini in view of Cheng U.S. Publication 2001/0032273 (Hereinafter Cheng), Machin et al., U.S. Publication 2002/0032806 (Hereinafter Machin) and Beck et al., 6,604,140 (Hereinafter Beck), as per office action dated 7/11/2005.

8. Claims 6, 7, 56, 104, 105, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuatini, Mead and Cheng in view of Beck, as per office action dated 7/11/2005.

9. Claims 12-18, 61-67, 110-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuatini, Mead, Cheng and Beck in view of Machin, as per office action dated 7/11/2005.

10. Claims 22, 71, 115, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuatini view of applicant's admitted prior art (AAPA), page 2-6 of the specification, as per office action dated 7/11/2005.

Allowable Subject Matter

11. Claims 8-11, 57-60 and 106-109 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is considered pertinent to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

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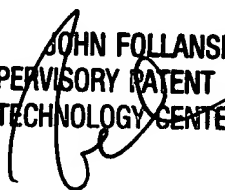
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

January 2, 2006


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100